

Notice of Allowability

Application No.

10/053,510

Applicant(s)

SABA ET AL.

Examiner

Art Unit

Delia M. Ramirez

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 3/4/2004.
2. ☒ The allowed claim(s) is/are 4-6.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

Status of the Application

Claims 4-6 are pending.

Applicant's remarks in a communication filed 3/4/2004 in response to a Non Final Office Action mailed on 11/4/2003 is acknowledged.

In a telephone conversation with Julie Urvater on 3/24/2004, an agreement was reached to amend claim 4 to place the application in condition for allowance.

Applicant's communication filed 3/30/2004 indicating the amendment of claim 11 of copending application 10/197073 such that it no longer recites " SEQ ID NO: 4" (SEQ ID NO: 4 in 10/197073 is the same as SEQ ID NO: 8 in the instant application) is acknowledged. In view of the amendment of claim 11 of copending application 10/197073 and cancellation of claims 11-12 of copending application 10/286,175, previous obviousness-type double patenting rejections applied to claims 4-6 are hereby withdrawn.

Examiner's Amendment

1. An informal Examiner's amendment to the specification appears below. This amendment adds a priority claim to the first line of the specification.

2. In page 1, immediately after the title, insert the following sentence:

This application is a continuation in part of U.S. Application No. 09/356,643 filed on 07/19/1999, now U.S. Patent No. 6,569,666, which is a continuation in part of U.S. Application No. 08/939,309 filed on 09/29/1997, now U.S. Patent No. 6,423,527.

3. An Examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

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4. Authorization for this Examiner's amendment was given in a telephone interview with Julie Urvater on 3/24/2004.

5. Please replace claim 4 as follows:

4. A method for identifying an agent that modulates sphingosine-1-phosphate lyase activity, comprising:

(a) contacting a candidate agent with a polypeptide comprising an amino acid sequence selected from the group consisting of:

an amino acid sequence set forth in SEQ ID NO:8; and

an amino acid sequence having at least 95% identity to a sequence set forth in SEQ ID NO:8;

wherein said polypeptide has sphingosine-1-phosphate lyase activity; and wherein the step of contacting is carried out under conditions and for a time sufficient to allow the candidate agent to interact with said polypeptide; and

(b) subsequently measuring the ability of said polypeptide to degrade sphingosine-1-phosphate or a derivative thereof, relative to an ability in the absence of said candidate agent, and therefrom identifying an agent that modulates sphingosine-1-phosphate lyase activity.

Reasons for Allowance

6. The following is an Examiner's statement of reasons for allowance. Although the prior art discloses sphingosine-1-phosphate lyases, the Examiner has found no teaching or suggestion in the prior art directed to the polypeptide of SEQ ID NO: 8 or a method for identifying modulators of the polypeptide of SEQ ID NO: 8. Therefore, claims 4-6 directed to a method for identifying modulators of sphingosine-1-phosphate lyase activity with the polypeptide of SEQ ID NO: 8, or variants thereof as recited in the claims, are allowable over the prior art of record.

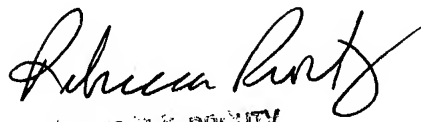
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7. Claims 4-6 are allowed.
8. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (571) 272-0938. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (571) 272-0928. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Delia M. Ramirez, Ph.D.
Patent Examiner
Art Unit 1652

DR
April 8, 2004


REBECCA R. KIRT
PRIMARY EXAMINER
GROUP 1800
1600